

**REMARKS**

Claims 1, 4 and 16-17 are pending. Claims 2-3 and 11 are canceled. Claims 5-10, 12-15, and 18-21 are withdrawn from consideration.

**Claim Rejections Under 35 USC § 112**

**Claim 1 is rejected under 35 U.S.C. 112, second paragraph.**

Independent claim 1 has been amended, as needed, to overcome this rejection.

Reconsideration and withdrawal of this rejection are respectfully requested.

**Claim Rejections Under 35 USC § 102 and 35 USC §103**

**Claims 1, 4 and 17 are rejected under 35 USC §102(e) as being anticipated by Beller et al, U.S. Patent No. 5,895,220.**

**Claim 16 is rejected under 35 USC §103(a) as being unpatentable over Beller in view of Merzenich et al.**

In the outstanding Office action, it is positively stated that:

“Column 11 lines 50-57, state that the parametric signal S is low-pass filtered using a capacitor to remove harmonics. Thus, an original sound is processed to form a region attenuated processed sound, the attenuation region being the high frequency range that included voice harmonics. Inherently, voice harmonics are found in the range above 7000 Hz, therefore the predetermined frequency region is in the region above the range 2000 Hz – 7000 Hz.

It should be noted that Beller indeed discussed removing harmonic pairs by a low-pass filter. However, Beller never discloses what the frequency range is of the harmonic pairs. In Beller, two specific frequencies are disclosed, respectively in column 7, line 43 of 17,000 Hz and in

column 9, line 67 of  $\frac{1}{4}$  Hz. As it is apparent that neither of these frequencies falls within what have been specified in claim 1, the claimed range is not anticipated. In fact, Beller never disclosed a range above 7000 Hz and a range above 2000 Hz – 7000 Hz. None of the applied art, alone or in combination, teaches or suggests the features of the amended claims.

Neither Beller et al., nor Merzenich et al., discloses the frequency range of the harmonic pairs, especially a range above 7000Hz and a range above 2000Hz – 7000Hz.

It is well settled that:

“A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference.”  
*Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1567, 7 USPQ2d 1057 (Fed. Cir. 1988).”

Should the Office continue to believe that independent claim 1, as amended, is still anticipated by the asserted prior art, a citation of where each and every claimed feature, either as column number and line number, or figure number and reference numeral, or a combination thereof, as disclosed in the asserted prior art is respectfully requested. Should the Office determines that any claimed feature is not disclosed in the asserted prior art, it is respectfully submitted that the claimed invention is not anticipated by the asserted prior art. Allowance of the claimed invention is then respectfully requested.

It should be noted that the frequency above 7000 Hz and above a range of 2000 Hz – 7000 Hz are only introduced by the Office through an inherency argument. Regarding inherency, MPEP 2163.01(a) has specifically stated that:

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain

thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Therefore, it is both a Patent Office position as well as a Court position that to establish inherency, the extrinsic evidence 'must' make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Should the Office continue to assert that the claimed invention is inherent, the Applicant respectfully requests the showing of any extrinsic evidence that makes clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Therefore, the claimed invention is neither anticipated by nor rendered obvious by the asserted prior art. Reconsideration and withdrawal of these rejections are respectfully requested.

**CONCLUSION**

In view of the aforementioned amendments and accompanying remarks, all pending claims are believed to be in condition for allowance, which action, at an early date, is requested.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully submitted,

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